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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MATTHEW D. FITZPATRICK, ALBERTO
GUTIERREZ, and WILLIAM R. WORGER

Appeal 2009-002,511
Application 10/749,083
Technology Center 2600

Decided: August 17, 2009

Before MAHSHID D. SAADAT, ROBERT E. NAPPI, and
CARLA M. KRIVAK, *Administrative Patent Judges*.

NAPPI, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 of the rejection of
claims 1-21. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm the Examiner's rejection of these claims.

INVENTION

The invention is directed to a method for providing an up-to-date contact list on a client device by receiving change messages from devices associated with the contact list. *See generally* Specification 8-9. Claim 1 is representative of the invention and reproduced below:

1. A method of determining availability of members of a contact list in a wireless communication system, wherein the method comprises:
 - determining an availability status of members of a contact list by receiving messages at a controller that indicate changes in availability of client devices associated with the contact list, the contact list corresponding to a particular client device; and
 - transmitting from the controller to the particular client device without a request from the particular client device information regarding the availability of the client devices only when a change has occurred in the availability of one or more of the client devices.

REFERENCES

Crockett	US 6,873,854 B2	Mar. 29, 2005 (filed Feb. 14, 2002)
Florkey	US 6,990,353 B2	Jan. 24, 2006 (filed Feb. 19, 2003)

REJECTION AT ISSUE

The Examiner rejected claims 1-21 under 35 U.S.C. § 103(a) as being unpatentable over Crockett in view of Florkey. Ans. 3-13.

ISSUES

Rejection of claims 1-21 under 35 U.S.C. § 103(a) as unpatentable over Crockett in view of Florkey

Claims 1, 3, and 4

Appellants argue on pages 5-6 of the Appeal Brief that the Examiner's rejection of claims 1, 3, and 4 is in error. We select independent claim 1 as representative of the group comprising claims 1, 3, and 4 since Appellants do not separately argue any of the claims with particularity. 37 C.F.R. § 41.37(c)(1)(vii). Appellants argue that neither Crockett nor Florkey teach determining an availability status of members of a contact list. App. Br. 5. Appellants additionally argue that neither Crockett nor Florkey teach transmitting the availability of devices to a particular client device only when a change has occurred. App. Br. 5-6. Lastly, Appellants argue that the Examiner has failed to provide a proper motivation to combine Crockett with Florkey.

Thus, with respect to claims 1, 3, and 4, Appellants' contentions present us with three issues. First, have Appellants shown that the Examiner erred in finding that Crockett in view of Florkey teaches determining an availability status of members of a contact list? Second, have Appellants shown that the Examiner erred in finding that Crockett in view of Florkey teaches transmitting the availability of devices to the particular client device only when a change has occurred? Third, have Appellants shown that the Examiner erred in finding it obvious to combine Crockett with Florkey?

Claim 2

Appellants argue on page 6 of the Appeal Brief that the Examiner's rejection of claim 2 is in error. Claim 2 is dependent upon claim 1.

Appellants present the same arguments discussed above with respect to claim 1. App. Br. 6. Appellants additionally argue that neither Crockett nor Florkey teaches storing changes in status of the devices in a queue.

Thus, Appellants' arguments with respect to the Examiner's rejection of claim 2 present us with the same issues as claim 1. Additionally, with respect to claim 2, Appellants' contention presents us with the issue: Have Appellants shown that the Examiner erred in finding that Crockett in view of Florkey teaches storing changes in status of the devices in a queue?

Claims 5-21

Appellants argue on pages 6-7 of the Appeal Brief that the Examiner's rejection of claims 5-21 is in error. Independent claims 5 and 15 contain limitations similar to claim 1 and claims 6-14 and 16-21 are dependent upon claims 5 and 15 (respectively). Appellants present the same arguments discussed above with respect to claim 1. App. Br. 6. Appellants additionally argue that neither Crockett nor Florkey teach periodically determining changes in availability of the devices. App. Br. 7.

Thus, Appellants' arguments with respect to the Examiner's rejection of claims 5-21 present us with the same issues as claim 1. Additionally, with respect to claims 5-21, Appellants' contention presents us with the issue: Have Appellants shown that the Examiner erred in finding that Crockett in view of Florkey teaches periodically determining changes in availability of the devices?

FINDINGS OF FACT

Crockett

1. Crockett teaches a user initiating a group (net) and a member list containing members to whom the user wishes to communicate with. Col. 11, ll. 4-11.
2. The system contains a media control unit (MCU) that maintains individual databases containing information about each of the net members. The information includes data such as a member's status in the net and "whether the member is actively participating in the net." Col. 20, l. 60 through col. 21, l. 5.

Florkey

3. Florkey teaches a communications system wherein a user of one mobile station is notified of the availability of users of a plurality of other mobile stations. Col. 1, ll. 13-19.
4. The system comprises application server components, networks, databases, session control components, data nodes, media resource function components, and mobile stations. Col. 2, l. 62 through col. 3, l. 1.
5. In order to determine whether a mobile station is available for a call, a buddy list service monitors a status of the mobile stations. The status indicates whether a mobile station is online, offline, busy, or on a call. Col. 3, ll. 13-17.
6. A user of one of the mobile phones administers the buddy list to view the availability of the user's friends, colleagues, and/or workgroup members. Col. 3, ll. 17-21.

7. Upon registration of the user, the application server component notifies the user (who is a subscriber to the buddy list service) of the status of the mobile stations that are listed on the user's buddy list. Col. 3, ll. 25-35.
8. In addition, if the status of any of the mobile stations that are listed on the user's buddy list change, the application server component notifies the user of the change in status. Col. 3, ll. 36-46.
9. In order to do a comparison between the availability of the mobile stations and the mobile stations included in the buddy list, the information has to be briefly stored. Col. 3, ll. 36-46.

PRINCIPLES OF LAW

Office personnel must rely on Appellant's disclosure to properly determine the meaning of the terms used in the claims. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 980 (Fed. Cir. 1995) (en banc). "[I]nterpreting what is *meant* by a word *in* a claim is not to be confused with adding an extraneous limitation appearing in the specification, which is improper." *In re Cruciferous Sprout Litigation*, 301 F.3d 1343, 1348 (Fed. Cir. 2002) (internal quotation marks and citations omitted; emphasis in original).

On the issue of obviousness, the Supreme Court has stated that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 416 (2007).

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it,

either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill. . . . [A] court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions.

Id. at 417. “One of the ways in which a patent’s subject matter can be proved obvious is by noting that there existed at the time of the invention a known problem for which there was an obvious solution encompassed by the patent’s claims.” *Id.* at 419-420.

The Examiner bears the initial burden of presenting a prima facie case of obviousness, and Appellant has the burden of presenting a rebuttal to the prima facie case. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). Appellant has the burden, on appeal to the Board, to demonstrate error in the Examiner’s position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006).

ANALYSIS

*Rejection of claims 1-21 under 35 U.S.C. § 103(a) as unpatentable over
Crockett in view of Florkey*

Claims 1, 3, and 4

Appellants’ arguments have not persuaded us that the Examiner erred in rejecting claims 1, 3, and 4. Appellants argue that neither of the references discloses determining an availability of a contact list. App. Br. 5.

The Examiner has found that this claim limitation is taught by Crockett since “a member list” is the same as the disclosed “contact list.” Ans. 14; FF 1, 2. We agree with the Examiner.

Claim 1 recites “determining an availability status of members of a contact list by receiving messages at a controller that indicate changes in availability of client devices associated with the contact list, the contact list corresponding to a particular client device.” Appellants argue that providing availability of the members on the member list to a particular member is not taught by the prior art reference. App. Br. 5. However, Crockett teaches a user initiating a group (net) and a member list containing members to whom the user wishes to communicate. FF 1. The group and resulting member list is associated with an initiating user and is therefore a list corresponding to a particular client device, as claimed. Further, a media control unit maintains individual databases that contain information about each of the net members including: a member’s status in the net and “whether the member is actively participating in the net.” FF 2. The media control unit, therefore, acts as a controller that receives messages that indicate the availability of members within a net or group. Therefore, Crockett does teach determining an availability of a contact list.

Appellants additionally argue that neither of the references teaches transmitting the availability of the client device only when a change has occurred. App. Br. 5-6. However, the Examiner has found that Florkey teaches this claim limitation. Ans. 15-16. Florkey teaches a system that comprises a buddy list which monitors the status of mobile stations to determine whether they are available to participate in a call. FF 3. An application server component controls the status notification of the mobile

stations to other mobile stations. FF 4. Upon a change in status of one of the mobile stations, the application server component sends an updated status notification to all of the mobile stations that contain the changed mobile station on their buddy list. FF 8. Therefore, Florkey does teach transmitting the availability only when a change has occurred.

Lastly, Appellants argue that there is no motivation to combine Crockett with Florkey. App. Br. 4-5. However, in *KSR*, the Supreme Court found that a teaching, suggestion, or motivation to combine the references was not required. *KSR*, 550 U.S. at 419. The Court characterized the TSM test merely as “helpful insight.” *Id.* at 419. In *KSR*, the Supreme Court has stated that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR*, 550 U.S. at 416. The combination of Crockett with Florkey would yield predictable results.

As stated above, both references deal with communications systems and both references recognize that it is beneficial to know the availability of other members of the communications system. Therefore, we consider using Florkey’s buddy list change status notification method with Crockett’s group member list and media control unit database management to be nothing more than using a known device to perform its known function. As such, the combination is obvious.

Even if the TSM test was still required, the Examiner has provided a motivation to combine the references. Ans. 16. The Examiner stated, on page 16 of the Answer, that the combination would “provide wireless communication system controlling list members availability notifications with real-time availability status presentation and ‘enhanced information

about the call status availability of mobile stations.” Ans. 16 (quoting Florkey col. 1, ll. 38-41 and 55-56). Appellants merely argue that there is no motivation because the references solve different problems. App. Br. 4. Therefore, Appellants’ argument has not identified an error in the Examiner’s reasoning as to why the skilled artisan would have combined the teachings. In the absence of such argument and evidence, the Examiner’s finding that a skilled artisan would have combined the references is sufficient as the Examiner has established that the combination is a predictable use of prior art elements according to their established functions.

Therefore, for the reasons stated above, we sustain the Examiner’s rejection of claims 1, 3, and 4.

Claim 2

Appellants’ arguments have not persuaded us of error in the Examiner’s rejection of claim 2. Claim 2 is dependent upon claim 1. Appellants present similar arguments with respect to claim 2 as for claim 1. App. Br. 6. As discussed above, the arguments with respect to claim 1 are not found to be persuasive and therefore the similar arguments with respect to claim 2 are also not found to be persuasive of error. However, claim 2 contains an additional limitation not found in claim 1. Claim 2 recites “storing the changes in availability of the client devices in a queue.” Appellants argue that the Examiner’s finding that a query is made is not the same as storing elements in a queue. App. Br. 6. The Examiner finds that Crockett teaches storing current status information in a queue. Ans. 9. The evidence supports this finding as Crockett teaches that a media control unit maintains a database for each of the members of a net or group. FF 2. The database includes information such as the member’s status in the net and

whether the member is actively participating. FF 2. In addition, Florkey teaches an application server component that processes status update messages to determine which mobile stations should be notified of the change. FF 8. In order to do a comparison between the availability and the buddy list, the information has to be briefly stored. FF 9. Thus, we sustain the Examiner's rejection of claim 2.

Claims 5-21

Appellants' arguments have not persuaded us of error in the Examiner's rejection of claims 5-21. Independent claims 5 and 15 contain limitations similar to those in claim 1 and claims 6-14 and 16-21 are dependent upon claims 5 and 15. Appellants present similar arguments with respect to claims 5-21 as for claim 1. App. Br. 6. As discussed above, the arguments with respect to claim 1 are not found to be persuasive and therefore the similar arguments with respect to claims 5-21 are also not found to be persuasive of error. However, Appellants additionally argue that neither Crockett nor Florkey teaches periodically determining changes in availability. App. Br. 7. Appellants' Specification does not specifically define the term "periodically." Therefore, the term "periodically determining a change" can be broadly construed to include "upon a change in status." As a result and as stated above, Florkey teaches the application server component sends an updated status notification to all the mobile stations that contain the changed mobile station on their buddy list upon a change in status (i.e., periodically) of one of the mobile stations. FF. 3, 7-8. Thus, we sustain the Examiner's rejection of claims 5-21.

CONCLUSIONS OF LAW

Appellants have not shown that the Examiner erred in finding that Crockett in view of Florkey teaches determining an availability status of members of a contact list.

Appellants have not shown that the Examiner erred in finding that Crockett in view of Florkey teaches transmitting the availability of devices to a particular client device only when a change has occurred.

Appellants have not shown that the Examiner erred in finding it obvious to combine Crockett with Florkey.

Appellants have not shown that the Examiner erred in finding that Crockett in view of Florkey teaches storing changes in status of the devices in a queue.

Appellants have not shown that the Examiner erred in finding that Crockett in view of Florkey teaches periodically determining changes in availability of the devices.

SUMMARY

The decision of the Examiner to reject claims 1-21 is affirmed.

Appeal 2009-002,247
Application 10/027,224

No period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

ELD

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